

**Appl. No.** : **09/782,586**  
**Filed** : **February 12, 2001**

### **REMARKS**

The August 27, 2004 Office Action was based upon pending Claims 1-19 and 21-34. This Amendment amends Claims 1, 2, 17, 26, and 34. Thus, after entry of this Amendment, Claims 1-19 and 21-34 are pending and presented for further consideration.

In the August 27, 2004 Office Action, the Examiner rejected Claims 1-19 and 21-34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,640,561 to Satoh (the "Satoh patent") in view of a publication regarding Microsoft's Exchange by Pagano et al. (the "Pagano reference").

In light of the following comments, Applicant respectfully requests allowance of pending claims 1-19 and 21-34.

### **REJECTION OF CLAIMS 1-25 AND 34 UNDER 35 U.S.C. § 103**

The Examiner rejected Claims 1-19 and 21-34 under 35 U.S.C. §103(a) as being unpatentable over the Satoh patent in view of the Pagano reference.

While a number of differences exist, generally speaking the Satoh patent maintains a replica of a source database. The Satoh patent, however, does not describe how to reconcile the source and replica database if the replica goes off-line and then needs to be recovered.

While the Pagano reference appears to discuss how to recover a database in the event of a system crash or other disaster, the Pagano reference does appear to provide any teaching regarding applying replication transactions from a source database to a target database.

In addition, the Pagano reference does not appear to teach a system wherein the source system remains available during recovery of the target database. Rather, the Pagano reference appears to describe how to recover a source database that has crashed and thus, the source database is not available during recovery.

In summary, neither reference, either alone or in combination, describes a system where stale information associated with the replication of a source database is purged before being applied to a recovered target database. In addition, neither

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reference, either alone or in combination, teaches a system wherein the source database remains available during recovery and reconciliation of the target database.

Section 2143 of the M.P.E.P. states that to establish prima facie obviousness three requirements must be met:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

First, there is no suggestion or motivation to combine the Satoh patent and Pagano reference to obtain a system that both recovers a target system and reconciles the target system with a source system such that the source system remains available during recovery and reconciliation of the target system.

Rather, it appears that the Examiner has impermissibly used hindsight derived from the teachings in the present application, and not the teachings of the prior art, to reject the claims. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (holding the Board impermissibly used hindsight in determining obviousness); See also, M.P.E.P., Sect. 2145, part X.A. In Dembiczak, the Federal Circuit reiterated that a determination of obviousness cannot simply rely on the inventor's disclosure as a "blueprint" without evidence of a suggestion, teaching or motivation in the prior art. Dembiczak, 175 F.3d 994, 999. Also, according to M.P.E.P. Section 706.02(j), "[t]he teaching and suggestion to make the claimed combination and the reasonable expectation for success must both be found in the prior art and not based on applicant's disclosure." (emphasis added).

Second, there must be a reasonable expectation of success. Because neither the Satoh patent nor the Pagano reference teach how to resolve inconsistencies that occur when recovering a target database that then receives stale replication transactions from a source system, there doesn't appear to be any expectation of success that the two systems when combined would address the such problems.

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Third, neither the Satoh patent nor the Pagano reference teach all the claimed limitations. For example, neither the Satoh patent nor the Pagano reference teach a source system that remains available during recovery and reconciliation of a target database.

Applicant therefore respectfully submits that independent Claims 1, 2, 17, 26 and 34 are patentably distinguished over the cited references and Applicant respectfully requests allowance of Claims 1, 2, 17, 26 and 34.

Furthermore, Claims 3-16 which depend from Claim 2, dependent Claims 18, 19, and 21-25 which depend from Claim 17, and dependent Claims 27-33 which depend from Claim 26 are believed to be patentable for the same reasons articulated above and because of the additional features recited therein.

Withdrawal of the rejection of Claims 1-19 and 21-34 under 35 U.S.C. §103(a) is therefore respectfully requested.

#### **REQUEST FOR TELEPHONE INTERVIEW**

Pursuant to M.P.E.P. § 713.01, in order to expedite prosecution of this application, Applicant's undersigned attorney of record hereby formally requests a telephone interview with the Examiner as soon as the Examiner has considered the effect of the arguments presented above. Applicant's attorney can be reached at (949) 721-2998 or at the number listed below.

#### **CONCLUSION**

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: 2/25/05

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